

HM12/1210

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EXAMINER	
SAOUD, C	
ART UNIT	PAPER NUMBER
1646	19

DATE MAILED: 12/10/99

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 29 Nov 1998 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - ☐ They raise the issue of new matter. (See Note).
 - ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: NONE

Claims objected to: NONE

Claims rejected: 1-14

However;

- ☐ Applicant's response has overcome the following rejection(s): _____

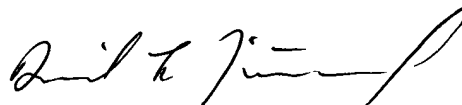
4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See attached
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

Applicant urges that Pötgens cannot anticipate the present claims because it teaches that none of the mutants examined inhibited native VEGF. A careful reading of the reference reveals that what Pötgens in fact teaches is that its mutants did not inhibit wild-type VEGF in a mitotic assay.

5 Applicant's argument would be persuasive if the claims required inhibition of mitotic activity. What the claims do require, however, is that the claimed mutant "be capable of inhibiting a biological activity of a native VEGF protein." This limitation would be met by a mutant which inhibits *any* biological activity of *any* native VEGF. Such activity could be, for example, the ability of native VEGF to compete for binding to the same receptor in a given
10 biological system. See the specification at 10, paragraph bridging to 11. Indeed, Fig. 6 of the Pötgens reference demonstrates that the several mutants do in fact compete with native VEGF for binding to its receptor. The evidence of record suggests that because the prior art mutants differ in structure and qualitative biological properties from at least one native VEGF, they are more likely than not to inherently possess functional attributes which meet the broadest reasonable
15 construction of the claims.

Examiner Saoud is on leave until February of 2000. In the interim, any inquiry concerning this communication should be directed to David Fitzgerald at telephone number (703) 308-3934 or fax number (703) 308-0294. Inquiries of a general nature should be directed to the Technology
20 Center 1600 receptionists at (703) 308-0196.



DAVID L. FITZGERALD
PRIMARY EXAMINER
ART UNIT 1646

9 December 1999